

Amendment and Response

Applicant: Robert Sesek

Serial No.: 09/887,833

Filed: June 21, 2001

Docket No.: 10006174-1 (H303.202.101)

Title: ELECTRONIC DOCUMENT SENDER SYSTEM AND METHOD WITH EXTERNAL ADDRESS
ACCESS

REMARKS

The following remarks are made in response to the Office Action mailed June 16, 2004. Claims 8, 16, 17, and 20-22 have been cancelled. No claims have been allowed. Claims 1-25 were rejected. With this Response, claims 1-2, 7, 11-12, 15, 18-19, and 24-25 have been amended. Claims 1-7, 9-15, 18-19, and 23-25 remain pending in the application and are presented for reconsideration and allowance.

The Specification

Regarding comments on the use of trademarks in the specification, Applicant has already included a trademark registration ® for "Windows", and used the generic terminology "brand operating system". In the context of the specification, all of the terms Apple, Microsoft and IBM have been amended to more fully specify their corporate names, as these terms reflect the corporate entities, and not trademarks for specific products. The terms "Bluetooth" and "IrDA" have been amended to reflect their formal designations as trademarks, along with inclusion of the generic terminology "protocol". Finally, regarding the term "infrared", Applicant believes that this is a generic term defining a portion of the electromagnetic spectrum, and the acronym FIR refers to a generic term fast infrared.

Accordingly, Applicant believes that appropriate use of company names and trademarks has been made.

Claim Rejections under 35 U.S.C. § 112

In the Office Action, claims 4, 22, 24, and 25 were rejected under 35 U.S.C. § 112, second paragraph as being indefinite.

Claim 22 has been canceled for other reasons, thereby obviating this rejection. Claims 4, 24 and 25 have been amended to provide proper antecedent basis for the identified elements of those claims. Accordingly, Applicant respectfully requests withdrawal of these rejections.

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Claim Rejections under 35 U.S.C. § 102

In the Office Action, claims 1-7, 9, 10, 15, 18, 21-23, and 25 were rejected under 35 U.S.C. § 102(e) as being anticipated by Murphy U.S. Publication 2002/0033961 (herein Murphy).

Independent claim 1 specifies a method of electronic document sending. The method comprises sending an electronic document from an electronic document sender to an electronic document receiver having an electronic address, and electronically obtaining the electronic address of the electronic document receiver, via wireless communication, from an address book located externally of the electronic document sender.

In contrast, Murphy discloses an address book 32 in Figure 3, containing subscriber's public encryption keys. These encryption keys are not equivalent to electronic address of an electronic document receiver, as claimed by Applicant. In Murphy, use of encryption is optional, allowing coding/uncoding of a data stream, i.e., the content of what is being sent, for security purposes. See Murphy at page 4, paragraph 59. Address information of the intended recipient is input via keypad 52 or other mechanisms, shown in Figures 8-9 (See Murphy page 4, paragraph 60 and page 5, paragraph 71), which are independent of address book 32 for encryption keys.

Moreover, Murphy fails to disclose electronically obtaining the electronic address of an electronic document receiver from an externally located address book via wireless communication. Despite the cited passage in Murphy page 3, paragraph 38, Murphy fails to suggest, teach etc. obtaining an electronic address from an external source via wireless communication. This cited passage does not address how/where electronic addresses are obtained, and only generally refers to wireless communication, with no guidance as to what parts of Murphy would employ that capability.

For these reasons, Murphy fails to anticipate or make obvious independent claim 1, and therefore independent claim 1 is believed to be allowable. Based on their dependency from independent claim 1, dependent claims 2- 6 are believed to be allowable as well.

Moreover, dependent claim 2 specifies that the external address book is located in a mobile computing device that is separate from the electronic document sender, and dependent claim 4 specifies that the mobile computing device is at least one of a personal digital assistant, a

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mobile phone, and a portable computer. In the Office Action, the cited passage in Murphy (page 7, paragraph 106) regarding a PCMCIA card slot 206 and such PCMCIA cards (e.g., flash memory, modem devices, cellular telephone communication devices, etc.) do not describe or suggest a mobile computing device separate from the electronic document sender that wirelessly communicates with the electronic document sender to provide electronic addresses to the electronic document sender. Instead, these PCMCIA cards, whatever function they perform, become a portion of the host machine when inserted into slot 206 and then do not operate independent or separate from their host machine outside of slot 206. Accordingly, these PCMCIA cards do not suggest or teach Applicant's claimed electronic document sender nor the separate mobile computing device that wirelessly communicates electronic addresses to the electronic document sender. Accordingly, dependent claims 2 and 4 are patentable over Murphy for these additional reasons.

Independent claim 7 specifies a method of document sending. The method comprises electronically importing an electronic address of an electronic document receiver, via wireless communication, from a mobile computing device into an electronic document sender, and sending an electronic document from the electronic document sender to the electronic document receiver using the electronic address.

Independent claim 7 is believed to be allowable for substantially the same reasons explained for the patentability of independent claim 1 (and dependent claims 2 and 4) over Murphy. In addition, Murphy further fails to disclose that the electronic address of the electronic document receiver is imported from a mobile computing device, which is independent of (i.e. separate from and external to) the electronic document sender. Murphy discloses neither the mobile computing device nor wireless communication to/from such a mobile computing device containing the electronic address for the electronic document receiver.

For these reasons, Murphy fails to anticipate or make obvious independent claim 7, and therefore independent claim 7 is believed to be allowable. Based on their dependency from independent claim 7, dependent claims 9-10 are believed to be allowable as well.

Independent claim 15 specifies an electronic document sending system comprising an electronic document receiver having an electronic address, a mobile computing device having an

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external address book with the electronic address of the electronic document receiver, and an electronic document sender. The electronic document sender is independent of the mobile computing device and is configured for sending an electronic document to the electronic address of the electronic document receiver and for obtaining, via electronic wireless communication, the electronic address from the address book of the mobile computing device.

Independent claim 15 is believed to be allowable for substantially the same reasons explained for the patentability of independent claims 1 and 7 over Murphy, since Murphy fails to disclose an electronic document sending system including an electronic document sender configured to obtain, via electronic wireless communication, the electronic address of an electronic document receiver from an address book of a mobile computing device.

For these reasons, Murphy fails to anticipate or make obvious independent claim 15, and therefore independent claim 15 is believed to be allowable.

Claim Rejections under 35 U.S.C. § 103

In the Office Action, claims 8, 12, 13, 16, 17, 19, 20 and 24 were rejected under 35 U.S.C. § 103(a) as being anticipated by Murphy.

Claims 8, 16, 17 and 20 have been canceled.

Independent claim 12 specifies an electronic document sender comprising an imaging mechanism configured for creating an electronic document from a paper document, a user interface, and a communication module. The user interface is configured for activating the imaging mechanism, configured for requesting an electronic address of an electronic document receiver from a mobile computing device that is external to and separate from the electronic document sender, and configured for initiating sending the electronic document to the electronic document receiver. The communication module is configured for wirelessly obtaining the electronic address from the separate mobile computing device and configured for sending the electronic document to the electronic address of the electronic document receiver.

Independent claim 12 is believed to be allowable for substantially the same reasons explained for the patentability of claims 1, 2-4, and 7 over Murphy.

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Moreover, user interface 94 of Murphy (cited in the Office Action) is not configured to request an electronic address of an electronic document receiver from a mobile computing device that is external to and separate from the electronic document sender. Instead, user interface 94 of Murphy appears to be limited to the functions of a keypad 52, system status displays 94, 96, etc. detailed in Murphy (see, e.g., page 5, paragraphs 66-67 and 71, Figs. 8-10), none of which include Applicant's claimed features of a user interface of an electronic document sender.

In addition, Murphy fails to disclose a communication module of an electronic document sender, in communication with the user interface, configured for wirelessly obtaining the electronic address from the separate mobile computing device.

For these reasons, Murphy fails to anticipate or make obvious independent claim 12, and therefore independent claim 12 is believed to be allowable. Based on their dependency from independent claim 12, dependent claims 13-14 are believed to be allowable as well.

Independent claim 19 specifies a mobile computing device comprising at least one of a portable computer, personal digital assistant, and a mobile phone, each of which includes an address book and a wireless communication module. The address book is configured to store at least one electronic address of an electronic document receiver. The wireless communication module is configured for transmitting the at least one electronic address from the mobile computing device to an electronic document sender that is separate from the mobile computing device.

For the substantially the same reasons explained for the patentability of claims 1, 2, and 4 over Murphy, Applicant submits that Murphy fails to disclose any such mobile computing device separate from an electronic document sender configured to perform the specified functions, as claimed in Applicant's independent claim 19.

In the Office Action, claims 11 were rejected under 35 U.S.C. 103(a) as being unpatentable over Murphy in view of Siitonen et al U.S. Patent 6,049,796 (herein Siitonen).

Dependent claim 11 specifies that the method of claim 7 additionally includes erasing the imported electronic address, after transmission of the electronic document from the electronic document sender, from at least one of an activity log and an internal address book of the electronic document sender.

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Dependent claim 11 is not disclosed by Murphy for substantially the same reasons previously explained regarding claim 7. While Siitonen discloses managing information via contact application (see Siitonen column 5, 20-23), neither Siitonen nor Murphy disclose or suggest erasing an electronic address from the electronic document sender after transmission of an electronic document (by the electronic document sender that uses the imported electronic address) where the electronic address had been wirelessly imported from a mobile computing device into the electronic document sender. Murphy simply does not disclose such importing or erasing of addresses, in the manner claimed, and Siitonen fails to cure the deficiencies of Murphy. Neither Murphy nor Siitonen suggest a combination of their respective devices and systems to achieve Applicant's claimed electronic document sender.

For these reasons, Murphy and/or Siitonen, alone or in combination, fail to make obvious dependent claim 11, and therefore dependent claim 11 is believed to be allowable.

In the Office Action, claims 14 was rejected under 35 U.S.C. 103(a) as being unpatentable over Murphy in view of Besprosvan U.S. Publication 2002/0124057 (herein Besprosvan).

Dependent claim 14 specifies that the user interface of the electronic document sender of claim 12 is configured to request, from the mobile computing device, a distribution list comprising a plurality of electronic addresses of electronic document receivers and the communication module is configured to obtain the distribution list of electronic addresses and send the electronic document to each electronic address in the distribution list

First, dependent claim 14 is believed to be allowable based upon its dependency from independent claim 12. In other words, dependent claim 14 is believed to be allowable over Murphy based upon substantially the same reasons previously explained regarding the patentability of claim 12 over Murphy. Besprosvan also fails to cure the deficiencies of Murphy. For these reasons, Murphy and/or Besprosvan, alone or in combination, fail to make obvious dependent claim 14, and therefore, dependent claim 14 is believed to be allowable.

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CONCLUSION

In view of the above, Applicant respectfully submits that pending claims 1-7, 9-15, 18-19, and 23-25 are in form for allowance and are not taught or suggested by the cited references. Therefore, reconsideration and withdrawal of the rejections and allowance of claims 1-7, 9-15, 18-19, and 23-25 is respectfully requested.

No fees are required under 37 C.F.R. 1.16(b)(c). However, if such fees are required, the Patent Office is hereby authorized to charge Deposit Account No. 50-0471.

The Examiner is invited to contact the Applicant's representative at the below-listed telephone numbers to facilitate prosecution of this application.

Respectfully submitted,

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CERTIFICATE UNDER 37 C.F.R. 1.8: The undersigned hereby certifies that this paper or papers, as described herein, are being deposited in the United States Postal Service, as first class mail, in an envelope address to: Mail Stop Amendment, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on this 16th day of September, 2004.

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